

### **Remarks**

The instant Office Action dated February 5, 2010 notes that prosecution has been re-opened after appeal, and lists the following new grounds of rejection: claims 1 and 5-18 stand rejected under 35 U.S.C. § 102(b) over Mao (U.S. Patent No. 6,037,755); claim 2 stands rejected under 35 U.S.C. § 103(a) over the '755 reference in view of Irvine (U.S. Patent No. 6,225,859); and claims 3-4 stand rejected under 35 U.S.C. § 103(a) over the '755 reference in view of Schneiderman (U.S. Patent No. 4,301,801). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses each of the asserted rejections generally because the correspondence and or motivation presented in the Office Action appears to be lacking. The following discussion provides examples of such deficiencies. These claims are understood to be allowable in part because of the additional current path and how it is used and claimed. The above claims are amended for clarity and to facilitate prosecution, and new claims 19-25 are believed to be allowable for reasons similar to that stated above. Support for the new claims may be found at paragraph No. 0036 and throughout Applicant's specification.

As a first more specific example of Applicant's bases for traversing, the § 102(b) rejection of claim 8 lacks correspondence to claimed aspects directed to a circuit element configured to enable and disable (open and close) the additional current path based on a current through the inductor. The Office Action has not asserted or provided any evidence to show these aspects are present in the '755 reference. Rather, the Examiner takes the position that these claimed aspects are functional and, therefore, are not required for correspondence (*see*, page 5 of the Office Action). This position is contrary to established U.S.P.T.O. policy and U.S. patent law. The claimed aspects recite that the circuit element has a structure that opens and closes the additional current path based on a current through the inductor. Moreover, all aspects deemed functional "must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language." Ex parte Bylund, 217 U.S.P.Q. 492, 498 (Bd. Pat. App. 1981);

*See, also*, M.P.E.P. 2173.05(g). Accordingly, a *prima facie* 102(b) rejection has not been presented and Applicant requests that it be withdrawn.

As another more specific example, Applicant traverses the § 102(b) rejection of claim 15 because the ‘755 reference lacks correspondence, for example, to aspects controlling enabling and disabling (opening and closing) of the additional current path to be responsive to a current through the inductor. The Examiner asserts that correspondence is inherent in the cited embodiment but fails to provide any support for this position. In order for a process of a method to be inherent in a device, the device must necessarily perform the process during normal operation. Applicant submits that the cited ‘755 reference does not close the additional current path (make non-conductive) in response to a current through the inductor. In contrast the ‘755 reference discloses that “when the additional current path [Q2] is on the diode [D2] becomes reversed biased (isolating the output from the input).” At this point the output is also isolated from the inductor. Because the control element of the cited embodiment of the ‘755 references makes switching determinations based on the isolated output voltage, the closing of the current path is not in response to any current through the inductor. Therefore, inherency has not been shown and the 102(b) rejection should be withdrawn.

As yet another more specific example, Applicant traverses the § 103(a) rejections of claim 2 and 3-4 because the Office Active has not presented a *prima facie* case of obviousness. “The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” *see* M.P.E.P. §2142. Applicant submits that the Examiner has not presented a valid motivation for modifying the teachings of the ‘755 reference with teachings of the respective ‘859 and ‘801 references. The Examiner suggests that one skilled in the art would be motivated to combine the ‘755 reference to include the controllable current source of the ‘859 reference for the purpose of sinking the current to ground. The Examiner also suggests that one skilled in the art would be motivated to combine the ‘755 reference to include the resistor of the ‘801 reference for the purpose of sinking the current to ground. Applicant submits that these reasons do not constitute a valid motivation because switch (Q2) already accomplishes the sinking to ground function as discussed throughout the ‘755 reference.

The Office Action has not suggested any reason why or how the additional current path of the '755 reference would be modified to include either the controllable current source of the '859 reference or the resistor of the '801 reference.

Applicant submits that the Examiner has simply identified a controllable current source and a resistor as elements used in electronic circuits (which can be found in any number of references) and then incorporated these elements into the '755 reference, using the claimed invention as a template. This is the hallmark of improper hindsight reconstruction with the proposed combination being derived, not "on the basis of the facts gleaned from the prior art," but solely from Applicant's disclosure. *See, e.g.*, M.P.E.P. § 2142. As explained in M.P.E.P. § 2143, "(t)he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." Because the goal asserted as motivation is already achieved by the '755 reference, the rejection of claims 2, 3, and 4 is improper. Applicant respectfully requests that the rejection be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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